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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,574	02/19/2004	Marvin P. Loeb	Loeb.M-04	7719

22197 7590 06/09/2005

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EXAMINER
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KASZTEJNA, MATTHEW JOHN

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/783,574	Applicant(s) LOEB ET AL.	
	Examiner Matthew J. Kasztejna	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-5, 9-10, 12-13, 15 and 29-33 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6,592,581 to Bowe.

**In regards to claims 1 and 29**, Bowe discloses an apparatus comprising: a means 32 for affecting tissue, the tissue affecting means disposed within a first enclosure 118 having a preferred shape; the first enclosure disposed within a second enclosure 100 and thereby constrained to the shape of the second enclosure, the second enclosure being more rigid than the first enclosure (see Col. 9, Lines 16-22); the first enclosure free to translate within the second enclosure, thereby extending from the second enclosure to assume the preferred shape so as to move proximate a tissue surface (see Col. 9, Line 61 – Col. 10, Line 5).

**In regards to claims 2, 9 and 31**, Bowe discloses an apparatus wherein the means for affecting tissue 32 is a source of energy (see Col. 12, Line 23).

**In regards to claim 3**, Bowe discloses an apparatus wherein the first enclosure 118 is a tube having a proximal end portion and a distal end portion (see Figs. 2 and 10).

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**In regards to claim 4**, Bowe discloses an apparatus wherein the second enclosure is a constraining sleeve 100 (see Figs. 2 and 3).

**In regards to claims 5, 10, 13, 30 and 32-33**, Bowe discloses an apparatus wherein the distal end portion 104 of the tube is made of a superelastic memory alloy treated to assume the preferred shape after being deformed therefrom (see Col. 9, Lines 40-60).

**In regards to claim 12**, Bowe discloses an apparatus wherein the preferred shape of the tube encompasses a bend having a bend angle of at least 10 degrees (see Fig. 2)

**In regards to claim 15**, Bowe discloses an apparatus wherein the tube is free to rotate within the sleeve (see Col. 12, Line 15).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8, and 16-23, 25-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,592,581 to Bowe in view of U.S. Patent No. 5,674,232 to Halliburton.

**In regards to claims 6-8, 16-23, 25-26 and 28** Bowe discloses an apparatus with a means 32 for affecting tissue but is silent with respect to the tissue affecting means being a burr or rotating guillotine blade. Halliburton teaches of an analogous

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tool having a housing 110, including an opening 120 and a primary shear or blade 130 which is connected to urging means such as cable or firing wire 104 for moving the primary shear 130 in the housing 110 across the opening 120 (see Col. 4, Lines 49-65). Furthermore, Halliburton teaches of numerous embodiments of the invention with regards to the construction of the housing, the primary shear and the opening (see Figs 1-12). It would have been obvious to one skilled in the art at the time the invention was made to use a burr as the tissue affecting means in the apparatus of Bowe to effectively remove obstructions from body channels as taught by Halliburton. The apparatus of Bowe and Halliburton is considered inherently capable of the recited method claims.

Claims 11, 14, 24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,592,581 to Bowe in view of U.S. Patent Application Publication No. 2004/0064015 to Goto et al.

**In regards to claims 11, 14, 24 and 28,** Bowe discloses an apparatus with a means 32 for affecting tissue but is silent with respect to the the sleeve being the instrument channel of an endoscope and the tube having exterior markings for indicating extension of the tube from the sleeve. Goto et al. teach of an analogous endo-therapy accessory device used in combination with an endoscope wherein the accessory device has external marking on its proximal and distal ends to indicate distance (see Figs. 1-3). It would have been obvious to one skilled in the rt at the time the invention was made to provide external markings on the distal and proximal ends of the tube in the apparatus of Bowe to allow the operator to recognize a projection length of the accessory when projected from a tip opening as taught by Goto et al.

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**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 4,926,858 to Gifford, III et al.

U.S. Patent No. 5,578,018 to Rowland et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK  
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6/6/05

  
BEVERLY M. FLANAGAN  
PRIMARY EXAMINER